

REMARKS/ARGUMENTS

Claims 1-25 are currently pending in the above-identified application. Claims 1 and 21-24 have been amended. In particular, claims 1 and 21-24 have been amended to remove the term "wherein applying the cutting surface includes reconstructing a root of the tooth", although Applicants expressly reserve the right to pursue claims of similar scope in a related application. Claims 1 and 21-24 have been further amended to recite the step of identifying "a line between the tooth and the adjacent structure". Support for these amendments is found throughout the specification including, for example, at Fig. 7 and paragraphs [68]-[69]. Claims 1 and 21-24 have further been amended to include the step of defining "a closed cutting surface that passes through the line between the tooth and the adjacent structure and that creates an approximate shape of a root of a tooth..." These amendments are supported throughout the specification including, for example, at Figs. 5 and 6 and paragraphs [62]-[67]. As such, no new matter is added by these amendments.

Regarding the Finality of the Office Action

Applicants initially submit that final rejection is improper in this instance because the claims rejected by the Examiner (Office action mailed 7/21/2005) were amended and submitted with the request for examination (RCE) submitted May 17, 2005 and, therefore, were different from those claims previously of record. Furthermore, the Examiner has presented new grounds of rejection that have not previously been made of record and to which Applicants have not been afforded opportunity to respond.

Applicants point out that final rejection is improper on the first Office Action following RCE, unless 1) all claims are drawn to the same invention claimed in the application prior to submission under 37 C.F.R. §1.114; and 2) all claims could have been finally rejected on both the grounds and the art of record in the next Office Action, had the claims been entered in the application prior to entry under 37 C.F.R. §1.114. See, e.g., MPEP § 706.07(b).

Here, Applicants submitted claims with the RCE submitted May 17th, 2005, which were amended to include elements that were not previously recited explicitly in the

claims. Additionally, the Examiner has, for the first time, rejected the claims as allegedly failing to comply with the written description requirement under 35 U.S.C. §112, first paragraph. Thus, final rejection at this stage is not only improper under the rules, but would also deprive Applicants of adequate chance to respond to the Examiner's new ground of rejection, thereby improperly denying Applicants of the full and fair examination to which they are entitled.

Accordingly, for the reasons set forth above, Applicants submit that final rejection is premature and respectfully request withdrawal of the finality of the rejection.

Rejections under 35 U.S.C. §112

Claims 1-25 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The rejection is traversed in part and overcome in part.

Applicants respectfully disagree that the originally filed application does not disclose that applying the cutting surface includes reconstructing a root of the tooth. As is known by the Examiner, there is no *in haec verba* requirement for satisfaction of the written description requirement under 35 U.S.C. §112, first paragraph. See, e.g., MPEP § 2163(I)(B). Applicants submit that one skilled in the art, viewing the present specification (see, e.g., Fig. 6 and paragraphs 65-67), would have recognized that Applicants were in possession of methods and computer programs where applying the cutting surface, for example, includes reconstructing a root of the tooth.

However, in order to advance prosecution of the present application, Applicants have amended claims 1 and 21-24 to more clearly recite subject matter that is supported in the originally filed specification, and the claims no longer recite the term "wherein applying the cutting surface includes reconstructing a root of the tooth." Applicants reserve the right, however, to pursue this subject matter in a related application. The amendments to current claims 1 and 21-24 are supported throughout the specification including, for example, at Figs. 5, 6, and 7, as well as at paragraphs 62-69.

Accordingly, for the reasons set forth above, Applicants respectfully request withdrawal of the rejection of claims 1-25 under 35 U.S.C. §112, first paragraph.

Rejections under 35 U.S.C. §102

Claims 1-25 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Chishti *et al.* (PCT Publication WO 98/58596 cited by applicant). The rejection is respectfully traversed.

It is alleged that Chishti *et al.* teaches a computer implemented method and system, as well as a computer program, for separating a tooth from an adjacent structure that anticipates the current invention as set forth in claims 1-25. The Examiner has not considered whether the limitation "applying the cutting surface includes reconstructing a root of the tooth" is found in the cited reference. Applicants respectfully disagree with the rejection of the claims.

However, without conceding the correctness of the rejection and while preserving the right to pursue claims of similar scope in a related later-filed, co-pending application, Applicants have amended claims 1 and 21-24 to clarify the distinctions with the cited reference in order to further expedite prosecution. In particular, claims 1 and 21-24 now recite that the methods and computer programs of the invention include "identify[ing] a line between the tooth and the adjacent structure..." Claims 1 and 21-24 further recite defining "a closed cutting surface that passes through the line between the tooth and the adjacent structure and that creates an approximate shape of a root of the tooth..." These elements of claims 1 and 21-24, which are incorporated into dependent claims 2-20 and 25, are missing from the teachings of Chishti *et al.*, thereby precluding a finding of anticipation.

Accordingly, Applicants submit that the cited reference fails to teach each and every element of the claimed invention and, therefore, withdrawal of the rejection of claims 1-25 under 35 U.S.C. §102(b) is respectfully requested.

Appl. No. 10/087,153
Amdt. dated November 21, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3732

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Date: 11/21/05



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